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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/576,386

05/22/2000

William T. Carden JR.

35672-163980

1657

7590

05/10/2006

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EXAMINER

HILLERY, NATHAN

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/576,386	Applicant(s) CARDEN, WILLIAM T.	
	Examiner Nathan Hillery	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 21,22,24-33,35-38,40-49,51-54,56-65 and 67-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21,22,24-33,35-38,40-49,51-54,56-65 and 67-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/2/05</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: Amendment filed on 2/27/06.
2. Claims 21, 22, 24-33, 35 - 38, 40 - 49, 51 - 54, 56 - 65, 67 - 76 are pending in the case. Claims 21, 37, and 53 are independent.
3. The rejection of claims 21 - 36; 37 - 52; and 53 - 68 under the judicially created doctrine of obviousness-type double patenting as being unpatentable has been withdrawn upon receipt of a terminal disclaimer.
4. The objection to the Claims has been withdrawn as necessitated by amendment.
5. The rejection of claims under 35 U.S.C. 112, second paragraph as being indefinite has been withdrawn as necessitated by amendment.
6. The rejection of claims 21, 22, 24 - 33, 35 - 38, 40 - 49, 51 - 54, 56 - 65, and 67 - 76 under 35 U.S.C. 103(a) as being unpatentable has been amended as necessitated by amendment.

### ***Terminal Disclaimer***

7. The terminal disclaimer filed on 12/02/05 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application Number 09/501169 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 21, 22, 24 – 33, 35 – 38, 40 – 49, 51 – 54, 56 – 65, and 67 – 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ivanov (US 5706452 A) and further in view of Leone et al. (US 5745360 A) and Bly et al. (US 5220657 A).

10. **Regarding independent claim 21**, Ivanov teaches that *in order to build a particular workflow application, a designer provides facilities to create, store, access, modify, delete documents and reviews, typically using a database management system. Each logical document and/or review can be implemented using a plurality of physical records. In the current embodiment, a document/review is implemented as a single Lotus Notes document, and all document related operations are provided by the Lotus Notes environment (2) defines the data components in the structure of each document and review. Document 44 stores data components for each role 48 and stage 50 relevant for its particular contents (Column 16, lines 20 – 31), compare with receiving a manuscript at a computer system, wherein said computer system includes at least one database to store a plurality of submissions, and wherein said plurality of submissions includes at least one of said manuscript, correspondence, a review, descriptive information, or a decision; storing said manuscript in said computer system, wherein said manuscript is accessible to a plurality of clients, wherein said plurality of clients includes an author of said manuscript, a reviewer, an editor, or a staff person managing at least one publisher; that modifications in the review authorizations between the moment the document is submitted and the moment reviews are requested can be reflected in the review process; in this respect,*

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*the reviewer list can be computed using the programming language just before notifications are sent out* (Column 6, lines 14 – 19), compare with **inviting at least one reviewer from a list of reviewers to review said manuscript, wherein said list of reviewers is maintained by said computer system;** and that *if at any time when it is a reviewer's turn to evaluate a proposal he/she composes a rejection, then the proposal itself is rejected. The preparer can choose to modify the proposal and resubmit it as a revision. The new proposal will go through the same approval process like the original one* (Column 27, lines 15 – 22), compare with **providing access to said manuscript to at least one reviewer who agrees to review said manuscript; receiving at least one review of said manuscript from said at least one reviewer who agrees to review said manuscript, said received at least one review including at least one of a revised manuscript, correspondence, recommendation, a score, relevant information, or said decision, wherein when said received at least one review is said decision, said decision is at least one of accepting, rejecting, or requesting at least one revision to said manuscript; providing said received at least one review related to said manuscript to at least one of said plurality of clients to collaboratively review said manuscript.** Ivanov teaches that *workflow manager 30 again examines document 44 and its associated reviews 46, and eventually deposits another notification 42 into system mail box 34. The process continues until document 44 is declared reviewed* (Column 7, lines 64 – 67), compare with **reporting said received at least one review about said manuscript.** Ivanov also discloses that the prior art teaches that *The IP system is a particular approval/rejection system. It does*

*not allow reviewers to grade documents or to express a degree of confidence in their grading. Such feature is important in systems that rank documents for comparative purposes, like bid evaluation, paper review, project proposal, etc. It also does not allow reviewers to contribute any information to the reviewed document, which is important in cases when earlier reviewers conduct research and publish the results for the use of later reviewers (Column 4, lines 20 – 28), compare with receiving a selection decision of whether to include said manuscript in at least one publication; determining at least one version of said manuscript to publish in said at least one publication when said selection decision is to include said manuscript in said at least one publication.*

11. Ivanov does not explicitly teach **translating**... However, Leone et al. teach that *the preferred embodiment of the invention is illustrated with regard to a special agent process that converts IBM's non-HTML formatted books created by the IBM BookManager Build process into HTML formatted ones. The special agent process will be called "DITA" herein. DITA is the core component process that produces the HTML formatted topics (both text and link anchors) generated by hypertext links. This provides real-time conversion of the non-HTML format to HTML. A hypertext link is the entry point into a discrete portion of a book. Performance considerations led to a design of serving only small discrete chunks, or portions of books, known as "topics", to Web browsers instead of processing the entire book at one time. (Column 5, lines 51 – 64), compare with **translating said manuscript from at least one input format to at least one user defined output format; receiving a submission at a computer system,***

**wherein said receiving said manuscript includes at least one of (i) receiving a file uploaded to said computer system or (ii) receiving data pertaining to said manuscript by a browser interface to said computer system.**

12. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Ivanov with that of Leone et al. because such a combination would allow the users of Ivanov the benefit of *an improved method and means for automatically converting non-HTML text and hypertext links to HTML texts and HTML links in electronically formatted documents for access over communications networks* (Column 1, lines 54 – 58).

13. Neither Ivanov nor Leone et al. explicitly teach **creating a proof of said submission to enable viewing and approval of said submission prior to storing said submission in said computer system.**

14. However, Bly et al. teach that *Job dockets includes drafts of text and illustrations, galleys and page proofs, specifications for design and layout, correspondence, and production schedules. A "job sheet" is often pasted on a docket's cover to identify the job and list its production schedule, e.g., a list of tasks to be accomplished, scheduled dates for completion, and individual worker assignments. Job dockets are passed from one worker to another as each job step is completed. Unlike a job docket, however, shared structured data objects are intended to allow several professional users to edit or otherwise work concurrently on the same publication* (Column 11, lines 51 – 62), compare with **creating a proof of said manuscript to enable viewing and approval of said submission prior to storing said submission in said computer system.**

15. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Ivanov and Leone et al. with that of Bly et al. because such a combination would allow the users of Ivanov and Leone et al. the benefit of *a representation of a shared structured data object can be used to present information about the activities and status relating to the shared structured data object and its content of a plurality of structured data objects as well as other information affecting or tracking the shared structured data object content* (Column 8, lines 43 – 49).

16. **Regarding dependent claim 22**, Ivanov discloses that the prior art teaches that *The IP system is a particular approval/rejection system. It does not allow reviewers to grade documents or to express a degree of confidence in their grading. Such feature is important in systems that rank documents for comparative purposes, like bid evaluation, paper review, project proposal, etc. It also does not allow reviewers to contribute any information to the reviewed document, which is important in cases when earlier reviewers conduct research and publish the results for the use of later reviewers* (Column 4, lines 20 – 28), compare with **receiving order decisions from at least one staff person, wherein said order decisions provide at least an arrangement for said manuscript in at least one publication; and determining contents of said at least one publication based on said order decisions.**

17. **Regarding dependent claims 24 and 70**, Ivanov teaches that *actual notifications sent to inform users of events related to a document are based on notification templates; the notification template to be used is identified for each role by evaluating a programming language expression; the text of the notification is further*



*customized substituting programming language expressions in the template with the result of their evaluation* (Column 6, lines 25 – 32), compare with **said manuscript includes data in the form of text, images, graphics, or multimedia; providing access to predetermined content of said manuscript.**

18. **Regarding dependent claim 25**, Ivanov teaches that *submission date information (...dat) identifies the time and date when document 44 has been submitted for review* (Column 15, lines 40 – 42), compare with **wherein when said plurality of submissions includes correspondence, said correspondence includes at least one of information about said author, subject matter of said manuscript, date and time of said submission, proposed publication dates, or proposed publications.**

19. **Regarding dependent claims 26, 28 and 29**, Ivanov teaches that *in the second solution, some reviewers do not have the authority to reject a proposal but they can argue why the proposal should be approved or rejected. Their comments are passed to higher ranking reviewers who can approve or reject a proposal; earlier reviewers also can dynamically modify the workflow by engaging the higher ranking reviewers who otherwise would not be involved in the review process* (Column 26, lines 36 – 43), compare with **said list of reviewers is provided to said computer system by at least one of said plurality of clients, that at least one of said plurality of clients produces said list of reviewers, and that said list of reviewers is based on qualifying criteria, wherein said qualifying criteria includes at least one of (i) a reviewer's area of specialty, (ii) a reviewer's prior review history, (iii) a reviewer's**

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**professional associations, (iv) a reviewer's availability, or (v) said author's preference for or against at least one reviewer.**

20. **Regarding dependent claims 27**, Ivanov teaches that *the reviewer list can be computed using the programming language just before notifications are sent out* (Column 6, lines 17 – 19), which provide that **said computer system produces said list of reviewers.**

21. **Regarding dependent claims 30 and 31**, Ivanov teaches that *some of the features of a workflow application built according to the present invention are: (a) provides different access (security) levels based on user's electronic identity, to protect sensitive information from unauthorized users ...* (Column 5, lines 14 – 18), which provide that **said computer system requires authentication of identity from at least one of said plurality of clients, and that requiring at least one of identification or authentication.**

22. **Regarding dependent claim 32**, Ivanov teaches that *if at any time when it is a reviewer's turn to evaluate a proposal he/she composes a rejection, then the proposal itself is rejected. The preparer can choose to modify the proposal and resubmit it as a revision. The new proposal will go through the same approval process like the original one* (Column 27; lines 15 – 22), compare with **receiving a revision to said manuscript, wherein the author of said manuscript provided said revision based on said received at least one review; and providing said revision to at least one reviewer for additional review.**

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23. **Regarding dependent claim 33**, Ivanov teaches that *FIG. 1 is a high level representation of a networked computer system 20, in particular, a Lotus Notes system. Such system connects a number of personal computers 22 and a number of server computers 24, allowing them to communicate. A user seated in front of personal computer 22 can create, access, modify, and delete data which is shared with other users and resides on server computer 24. Each user has an electronic identity and can communicate with other users via an electronic mail system* (Column 7, lines 23 – 31), which provide that **said plurality of clients access said computer system via at least one of the Internet, an extranet, or an intranet.**

24. **Regarding dependent claim 35**, Ivanov teaches that *workflow manager 30 again examines document 44 and its associated reviews 46, and eventually deposits another notification 42 into system mail box 34. The process continues until document 44 is declared reviewed* (Column 7, lines 64 – 67), compare with **reporting acceptability information compiled from said received at least one review.**

25. **Regarding dependent claims 36 and 69**, Ivanov teaches that *participants do not have to know or select who has to review a document next* (Column 5, lines 32 – 34), compare with **wherein information about said author and said at least one reviewer are not provided with said manuscript to at least one of said plurality of clients; wherein information about said author and said at least one reviewer who agrees to review said manuscript are not provided to at least one of said plurality of clients.**

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26. **Regarding dependent claim 71**, Ivanov teaches that *Documents and their associated reviews are stored into a database which is permanently monitored by a workflow manager. Reviewers are notified by the workflow manager that a document is ready for their review via electronic mail, and they can review a document in parallel. A rigid OR/AND synchronization schema is hard coded into the system. Although roles and barriers can be added, eliminated, or moved around, the methodology suggested by the IP system lacks flexibility as exemplified below. The IP system is a particular approval/rejection system. It does not allow reviewers to grade documents or to express a degree of confidence in their grading. Such feature is important in systems that rank documents for comparative purposes, like bid evaluation, paper review, project proposal, etc. It also does not allow reviewers to contribute any information to the reviewed document, which is important in cases when earlier reviewers conduct research and publish the results for the use of later reviewers* (Column 4, lines 12 – 28), compare with **publishing predetermined content from said database**.

27. **Regarding claims 37, 38, 40 – 49, 51 – 54, 56 – 65, 67, and 68**, the claims incorporate substantially similar subject matter as claims 21, 22, 24 – 33, 35 and 36, and are rejected along the same rationale.

28. **Regarding dependent claims 72 - 76**, the claims incorporate substantially similar subject matter as claims 69 - 71, and are rejected along the same rationale.

### ***Response to Arguments***

29. Applicant's arguments filed 2/27/06 have been fully considered but they are not persuasive.

30. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., enable reviewers to each review all portions of a document) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

31. In response to applicant's arguments that Ivanov does not teach, suggest, or disclose **inviting at least one reviewer from a list of reviewers to review said submission, where said list of reviewers is maintained by said computer system**, it should be noted that Ivanov teaches that *modifications in the review authorizations between the moment the document is submitted and the moment reviews are requested can be reflected in the review process; in this respect, the reviewer list can be computed using the programming language just before notifications are sent out* (Column 6, lines 14 – 19), which is synonymous to **inviting at least one reviewer from a list of reviewers to review said submission, where said list of reviewers is maintained by said computer system**. The Office has interpreted Ivanov's request for a review as the claimed invention's invite.

32. In response to applicant's arguments that Leone et al. do not teach, suggest, or disclose **translating a document form at least one input format to at least one user defined format**, it should be noted that by applicant's own admission Leone et al. translates a document into HTML format (p25, last paragraph, line 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to be well

aware that HTML is a user defined format, since the skilled artisan can use HTML code to create and/or modify an HTML document thus defining the format.

### ***Conclusion***

33. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

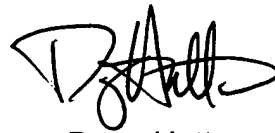
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on (571)-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'D. Hutton', with a stylized flourish at the end.

Doug Hutton  
Primary Examiner  
Art Unit 2176

NH